



FEB 19 2002

In re

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: DECISION ON  
:  
: PETITION FOR REGRADE  
:  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 28, 39, 43, and 49 of the morning session and question 42 of the afternoon session of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 66. On July 28, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 10.2

and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: “No points will be awarded for incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner’s arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points. No credit has been awarded for morning question 28, morning question 39, morning question 43, or morning question 49. No credit has been awarded for afternoon question 42. Petitioner's arguments for these questions are addressed individually below.

Morning question 28 reads as follows:

28. Practitioner Smith filed a utility patent application on January 5, 2001, with informal drawings. Upon review of the drawings, the USPTO concluded that the drawings were not in compliance with 37 C.F.R. § 1.84(a)(1) and (k), and were not suitable for reproduction. In an Office communication, Smith was notified of the objection and given two months to correct the drawings in order to place the application in the files of a Technology Center for examination. Which of the following complies with USPTO practices and procedures for a complete *bona fide* attempt to advance the application to final action?

- (A) Smith timely files a response requesting that the objections to the drawings be held in abeyance until allowable subject matter is indicated.
- (B) Smith timely files a response requesting that the objections to the drawings be held in abeyance since the requirement increases up-front costs for the patent applicant, and the costs can be avoided if patentable subject matter is not found.
- (C) Smith timely files a response requesting that the objections to the drawings be held in abeyance until fourteen months from the earliest claimed priority date.
- (D) Smith timely files a response correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction.
- (E) All of the above.

The model answer is selection (D).

Under 37 C.F.R. § 1.85(a), correcting the drawings to comply with 37 C.F.R. § 1.84(a)(1) and (k), and making them suitable for reproduction is a *bona fide* response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 C.F.R. § 1.85(a) (effective November 29, 2000), "Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the

drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57032, “Section 1.85.” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

Petitioner argues that “the Model Answer ignores the realistic possibility that Smith could appropriately proceed with steps in choices (A) through (C) given that the facts do not specifically state that no such Office action took place.” The argument is not persuasive. The “DIRECTIONS” for the Morning Session included the following instruction: “Do not assume any additional facts not presented in the questions.” Morning question 28 did not state that Smith received an Office action notifying Smith that the objections to the drawings could be held in abeyance. Accordingly, it would be improper to assume that Smith received such an Office action. (D) is the most correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 28 is denied.

Morning question 39 reads as follows:

39. Which of the following is/are required to be included in a request for reexamination submitted by a person other than the patent owner on January 12, 2001?

(A) A statement pointing out each substantial question of patentability based on the arguments stated by the examiner in the first Office action.

(B) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112.

(C) A copy of the entire patent including the front face, drawings, and specification/claims, in double column format on single-sided sheets, for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.

(D) A certification that a copy of the request has been served in its entirety on “the patent owner at the address as provided for in § 1.33(c),” without indicating the name and address of the party served.

(E) None of the above.

The model answer is selection (C).

37 C.F.R. § 1.510(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (September 8, 2000). As stated in 65 FR at 54649, middle column, “Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only.” Thus (C) is correct. (A) is incorrect because 37 C.F.R. § 1.510(b)(1) requires that each substantial new question of patentability be based on prior patents and publications. (B) is incorrect because the statement in (B) is required by 37 C.F.R. § 1.293(b), not by 37 C.F.R. § 1.510(b). (D) is incorrect because under 37 C.F.R. § 1.510(b)(5), the name and address of the party served must be indicated if the request is by a person other than the patent owner.

Petitioner argues that in answer (C), the modifying phrase “in double column format on single-sided sheets,” appears to be modifying only “specification/claims,” rather than the entire series of phrases which preceded the modifier. There is no reason why answer (C) must repeat each and every requirement of 37 C.F.R. § 1.510(b)(4) in order to be the most correct answer. It is true that the “specification/claims” must be provided in double column format on single sided-sheets. Accordingly, even if answer (C) is given the interpretation proposed by petitioner, answer (C) is the most correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 39 is denied.

Morning question 43 reads as follows:

43. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart’s reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was

also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

The model answer is selection (C).

MPEP § 608.04(c) includes the following recitation:

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.

See, also, MPEP § 706.03(o), which includes the following recitation:

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph.

[Note re Question 43, third line of factual background: Examination proctors were instructed to direct examination candidates to delete from the third line of the factual background the word -- in--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.]

Petitioner argues that (B) is the most correct answer because it reflects the

understanding that the new matter in Amendment #2 did not affect the claims. The argument is not persuasive. The fact pattern indicates that Amendment #2 introduced a change to the specification, and that the change was also introduced to all of the claims in the application. MPEP § 608.04(c) provides that “where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.” Answer (C) is the most correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 43 is denied.

Morning question 49 reads as follows:

49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

- (A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.
- (B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.
- (C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.
- (D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.
- (E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

The model answer is selection (C).

See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001), "A claimed invention must have a specific and substantial utility. This requirement excludes 'throw-away,' 'insubstantial,' or 'nonspecific' utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101." (A) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), "An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement." (B) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), "Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the *prima facie* showing of no specific and substantial credible utility." (D) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001), wherein it states, "An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible." (E) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

Petitioner argues that the procedure described in choice (B) does not appear aligned with proper USPTO practice because it suggests that documentary evidence is sufficient and adequate to "show" a factual basis, whereas 66 FR 1092, 1098 states that the examiner should provide documentary evidence to "support" a factual basis. The argument is not persuasive. If documentary evidence is strong enough to "show" a factual basis as set forth in choice (B), it is in accord with proper USPTO practice and procedure. Note that the "Utility Examination Guidelines" refer to the "*prima facie* showing of no specific and substantial credible utility." The Guidelines indicate that the *prima facie* showing "must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would



be specific and substantial.” See “Utility Examination Guidelines,” 66 F.R. 1092, 1098, right-hand column (Jan. 5, 2001). Accordingly, use of the word “show” in choice (B) is aligned with proper USPTO practice. Answer (B) is the most correct answer. No error in grading has been shown. Petitioner’s request for credit on morning question 49 is denied.

Afternoon question 42 reads as follows:

42. You prepare and file a patent application directed to an invention for improving the safety of research in the field of recombinant DNA. Your client, Inventor Joe, informs you he has licensed exclusive rights to his invention to a major pharmaceutical company. Inventor Joe also informs you that he is aware that another pharmaceutical company, Titan Pharmaceuticals, learned of the invention from a paper he presented at a technical conference, and is preparing to use the technology in its commercial research labs in the United States. Inventor Joe demonstrates that Titan is about to begin practicing the invention by showing you a rigid comparison of Titan's intended activities and the claims of the application. He also informs you that although he is currently in very good health, he is 67 years old and fears he will not be in good health when the invention reaches its peak commercial value. Accordingly, if possible he would like for you to expedite prosecution in the simplest, most inexpensive way. Given the foregoing circumstances, which of the following statements is most correct?

(A) You should recommend filing a petition to make special on the basis of Inventor Joe's age.

(B) Since the invention relates to improving the safety of research in the field of recombinant DNA, you should recommend filing a petition to make special on that basis.

(C) Since Titan is actually practicing the invention set forth in the pending claims, you should recommend filing a petition to make special on that basis.

(D) Statements (A), (B) and (C) are equally correct.

(E) Statements (A), (B) and (C) are each incorrect.

The model answer is selection (A).

A petition to make special may be made simply by filing a petition including any evidence showing that the applicant is 65 years of age or more, such as a birth certificate or a statement from the applicant. No fee is required. MPEP § 708.02. Although a petition to make special as indicated in statement (B) is likely available, it would require a petition fee. *Id.* A petition to make special as indicated in statement (B) is likely not available because such a petition may not be based on prospective infringement. *Id.* Also, even if a petition as indicated in statement (C) were available, it would require a petition fee. Thus, neither of these options would be the most inexpensive. (B) also requires a statement explaining the relationship of the invention to safety of research in the field of recombinant DNA research.

Petitioner argues that the call of the question does not specify that the correct answer was one which did not require *any* additional fees. The argument is not persuasive. As provided in 37 C.F.R. § 1.102(c), “A petition to make an application special may be filed without a fee if the basis for the petition is the applicant’s age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.” As further provided in 37 C.F.R. § 1.102(d), “A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).” Choice (A) is the simplest, most inexpensive way to expedite prosecution because the application may be made special “upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement.” See MPEP 708.02. A petition as indicated in statement (B) is likely available, but it requires a fee and statements “explaining the relationship of the invention to safety of research in the field of recombinant DNA research.” Accordingly, the petition in statement (B) is less simple and more expensive than the petition as indicated in statement (A). See MPEP 708.02. Regarding choice

(C), a petition on the grounds of actual infringement would be complicated and costly. A petition as indicated in statement (C) would require a statement that “there is an infringing device or product actually on the market or method in use.” See MPEP 708.02. Such a statement would appear to be unsupported by the facts. Making a material false statement could violate one or more disciplinary rules set forth in the Patent and Trademark Office Code of Professional Responsibility. A violation of the disciplinary rules could, in turn, result in reprimand, suspension, or exclusion of a practitioner under 37 C.F.R. 10.130. Additionally, as in the case of the petition in statement (B), the petition in statement (C) would require the fee under 37 C.F.R. § 1.17(h). Statement (D) is incorrect because statements (A), (B), and (C) all have different levels of complexity, and because petitions filed as provided in statements (B) and (C) require the fee set forth in 37 C.F.R. § 1.17(h), whereas the petition as provided in statement (A) is simple to prepare and file, and it does not require the fee. Statement (E) is incorrect because the petitions in statements (A) and (B) are both reasonable ways of expediting prosecution according based on the facts given.

Answer (A) is the most correct answer. No error in grading has been shown.

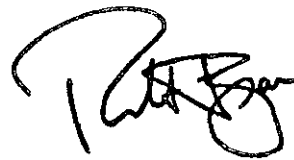
Petitioner’s request for credit on afternoon question 42 is denied.

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above the printed name and title of the official.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy